

## REMARKS

### Introductory Comments:

Claims 11-20 were examined in the Office Action dated June 21, 2006.

Claims 11-20 were rejected on the grounds of non-statutory obviousness-type double patenting over U.S. Patent No. 6,686,152.

Claims 11-20 and 28 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,470,705 to Grossman et al. (Grossman) in view of U.S. Patent No. 5,851,770 to Babon et al. (Babon).

### **Addressing the Examiner's Rejections**

#### **Rejections of the Claims Under 35 U.S.C. §103(a)**

The Examiner rejected claims 11-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Grossman in view of Babon.

The applicants traverse the rejection. In order for the Office to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teachings or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The combination of

the cited references do not disclose all the elements of the applicants' claims, therefore, a *prima facie* case of obviousness has not been made.

In the Office Action under reply, the Examiner on page 5, last paragraph, acknowledges that Grossman and Babon "do not explicitly disclose the capture agent which confers on the undigested electrophoretic probes a charge that causes the undigested electrophoretic to migrate upon electrophoretic separation in a direction opposite of that of the e-tag reporters, thereby excluding said undigested electrophoretic probes from the electrophoretic separation of the released e-tag as recited in claim 11." Nevertheless, the Examiner states that because the dependent claims have the same characteristics as the disclosure of Babon, the capture ligands and agents of claim 11 would have the inherent property claimed in the independent claims. The applicants are not aware of any section in the MPEP or case law that supports the Examiner's reasoning. If the Examiner wishes to support the assertion from personal experience, then such an assertion should be submitted in the form of an Examiner's affidavit. When a rejection is based on facts within the personal knowledge of the Examiner, the data should be stated as specifically as possible, and the reference must be supported, when called for by the applicant, by an affidavit from the Examiner (MPEP 706.02(a)). Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons (37 C.F.R. 1.107). The Examiner is requested to provide such an affidavit if the rejection is to be maintained.

The applicants' independent method claim 11 pertains to excluding the undigested electrophoretic probes where they migrate in a direction opposite of that of the eTag reporters. Thus, the same sample contains the undigested electrophoretic probes and the eTag reporters, and a single separation resolves the two. This is not disclosed in Grossman or Babon either

individually or in combination. Babon discloses that a magnetic field is applied to the mixture to separate the reacted from the unreacted material (step e, abstract), and the reacted material is then separated. Babon thus teaches two steps to separate the reacted from the unreacted material. In contrast, the claimed method is to a single separation to resolve the undigested electrophoretic probes and the eTag reporters. The deficiency of Babon is not cured by Grossman. Thus, the combination of the references does not disclose all the elements of the applicants' claims.

Further, Grossman does not disclose or teach detecting the presence or absence of one or more target compounds. In Grossman, the probes are specific to a single target polynucleotide (abstract). And the probes disclosed by Grossman do not have a cleavable linkage L. The Grossman probes are disclosed in Figure 1 and discussed at column 6, line 56-column 8, line 28. At column 6, line 66 to column 7, line 3, the reference states that the "[p]robe 20 includes an oligonucleotide binding polymer 22 which preferably includes at least 10-20 bases, for requisite basepair specificity, and has a base sequence which is complementary to region 24 in target polynucleotide 26, with such in single-stranded form." At no point does Grossman disclose electrophoretic probes having a cleavable linkage L. The disclosure teaches the entire sequence specific probe has distinctive electrophoretic mobility. In contrast, the claims pertain to a reporter that is produced by cleavage such that it is produced with a unique electrophoretic mobility.

The combination of Grossman and Babon does not disclose all the elements of the claims, and therefore, a *prima facie* case of obviousness has not been presented by the Office. Therefore, the Examiner is respectfully requested to withdraw the rejection.

### **Provisional Rejections of the Claims Under Double Patenting**

Claims 11-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 6,686,152. The applicants will consider filing a terminal disclaimer upon indication of allowable subject matter.

### **CONCLUSION**

Applicants respectfully submit that the claims define an invention that is patentable over the art, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicants' representative at (650) 335-7818.

Respectfully submitted,  
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